

### **REMARKS/ARGUMENTS**

Applicant thanks the Examiner for review of the present application. Claims 1-20 were previously pending in the application and remain pending as a result of the present amendment to the application.

The Office Action of April 3, 2007, rejects Claims 1-19 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0148229 to Maxwell et al. ("the Maxwell publication").

Applicant has amended numerous claims and provides the following remarks in response to the rejections of the Office Action, requests reconsideration, and submits that the rejections of Claims 1-19 are respectfully overcome by the present amendments and remarks which follow. Applicant finds no rejection of Claim 20 in the Office Action.

#### **Rejections Under 35 U.S.C. § 102(e)**

Applicant respectfully submits that the Maxwell publication fails to anticipate the present invention and pending claims as un-amended. However, to further prosecution of the present application, Applicant hereby provides amendments to the claims to more clearly, definitively, and expressly claim the subject matter which Applicant regards as the invention. In particular, Applicant has amended Claims 1, 3-4, 6-16, and 19-20 to highlight and emphasize the distinctive features and functionalities of the present invention and pending claims.

With regard to Claims 1, 8-12, and 17-19, the Office Action states that the Maxwell publication teaches a monitor for monitoring the on-line use of the downloaded application. However, the Maxwell publication does not teach the monitoring of an application's use. Further, it does not teach the monitoring of the application's use at a client. Rather, it teaches only the monitoring of the state of the application. In the Office Action, Examiner cites paragraph [0039] to illustrate that the Maxwell publication anticipates the present invention. In this paragraph, the Maxwell publication speaks of a web server that ensures that the state of the application is up-to-date with respect to valid registration keys and the latest upgrades. This monitoring in no way teaches nor suggests a monitor for monitoring the use of the downloaded application in an on-line mode, and it further does not teach nor suggest use at the client. Moreover, the Maxwell publication neither teaches nor suggests providing support by the service provider unit for the use of the application in an on-line mode at the client.

The Office Action further contends that the Maxwell publication teaches a controller configured to control the processor to provide the on-line use of the downloaded application, dependent on the

monitoring of the on-line use of the downloaded application. The Examiner cites paragraph [0052] of the Maxwell publication as the anticipating language. However, this paragraph states that the traffic controller functioning is dependent on the server's availability and busyness. Conversely, the controller in the present invention is configured to control the processor to provide the use of the downloaded application in an on-line mode dependent on the monitoring of the use.

The Office Action also asserts that the Maxwell publication teaches a processor for running the application off-line whenever desired by the user and for running the downloaded application on-line when desired by the user if allowed by the controller. The Examiner cites paragraphs [0040], [0050], [0057], and [0200] as the anticipating language. However, the off-line activity discussed in these paragraphs speaks to the registration of information required to purchase software and the purchasing of the software, pending a synchronization operation. The on-line activity discussed in these paragraphs speak to allowing software vendors to retrieve a list of their registered users and to manage software they have available, and to initiating a synchronization operation that will complete the software purchasing process and provide the registered users with any of the vendors' software updates. By comparison, the present invention claims a processor for running the downloaded application in an off-line mode whenever desired by a user of the client and for running the downloaded application in an on-line mode when desired by a user of the client if allowed and supported by the controller, dependent on the monitoring. The off-line and on-line activities of the Maxwell publication do not contemplate running the downloaded application in an off-line or on-line mode, and further do not contemplate running at the client as opposed to at the server.

Similarly, with respect to Claims 13-16, the Office Action contends that the Maxwell publication teaches a computer executable program code configured to enable the network to monitor on-line use of the downloaded application and computer executable program code configured to enable the network entity to control the providing of the on-line use of the downloaded application dependent on the monitoring of the on-line use of the application. The Examiner cites paragraphs [0170-176] of the Maxwell publication as the anticipating language. As discussed previously, the on-line activity of the Maxwell publication speaks to allowing software vendors to retrieve a list of their registered users and to manage software they have available, and to initiating a synchronization operation that will complete the software purchasing process and provide the registered users with any of the vendors' software updates, but the reference in no way discusses controlling the providing of use of the downloaded application in both an off-line and an on-line mode.

Further, Applicant notes that the Office Action does not present any explanation for how the Maxwell publication teaches each and every limitation of Claims 8-12 or 17-19. Only the limitations of Claim 1 are discussed in the Office Action.

As such, Applicant respectfully submits that the Office Action fails to present *prima facie* evidence of anticipation because the Maxwell publication does not teach each and every element of any of the claims. The Maxwell publication may teach or suggest similar sounding features and functions as the present invention, but it does not teach or suggest each and every element of any of the subject claims, particularly with regard to running the downloaded application in an on-line mode and the monitoring of the use of the downloaded application in an on-line mode at a client and supported by the service provider unit.

#### *Additional Remarks*

As noted, Applicant amended Claims 1, 3-4, 6-16, and 19-20 to highlight and emphasize the distinctive features and functionalities of the present invention and pending claims. Particularly, Applicant substituted the usage of "off-line use" and "on-line use" with "in an off-line mode" and "in an on-line mode." This amendment emphasizes that the on-line and off-line activities discussed in the claims refer to a particular mode in which the downloaded application is used at the client. Paragraph [0003] of the application for the present invention (U.S. Patent Application Publication No. 2004/0185872 to Emmerson et al.) is illustrative of this where the downloaded application is a game and the game can be played alone in a single player mode or over a network in a multi-player mode so that some other party play the same game over a network connection. The off-line mode in this example refers to a user of the client playing the game in single player while the on-line mode refers to the user playing the same game at the client network in a multi-player mode.

As such, Applicant submits that each and every limitation of Claims 1-20, with Claims 1, 3-4, 6-16, and 19-20 being amended, are not disclosed, taught, nor suggested by the Maxwell publication. Accordingly, for at least the reasons presented above, Applicant submits that independent Claims 1 and 8-16 and Claims 2-7 and 17-20 that depend there from are patentable over the cited prior art. Thus, it is respectfully requested that Examiner allow the pending claims

#### Conclusion

In view of the foregoing comments, Applicants submit that all of the pending claims of the present application, as amended, are in condition for allowance. It is therefore respectfully requested that

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a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper, such as fees for a request for an extension of time. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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